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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/009,022	12/03/2001	Boaz Harari	687-412	5829

7590 02/06/2004
Jeffrey J Hohenshell
AMS Research Corporation
10700 Bren Road West
Minnetonka, MA 55343

EXAMINER

PHILOGENE, PEDRO

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 02/06/2004

14

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/009,022	Applicant(s) HARARI ET AL.	
	Examiner Pedro Philogene	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22, 24-63 and 65-78 is/are pending in the application.
- 4a) Of the above claim(s) 1-22, 24-62 and 66-78 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 63 and 65 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12</u> . | 6) <input type="checkbox"/> Other: ____. |

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 63,65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pietrzak et al (5,527,342) in view of Sohn (WO/97/47246).

With respect to claims 63,65, Pietrzak et al discloses a detachable tip (10) for a needle comprising a tip (12) having a sharp end and adapted for boring through bone, an extension (16) of the tip apposite of the sharp end and a substantially longer than the sharp tip, attached to a thread (50).

It is noted that Pietrzak et al did not teach of a flexible extension and a sharp end adapted for being grasped by a hollow needle, at a side of the sharp tip opposite of the extension or at a side of the extension; as claimed by applicant. However, in a similar art, Sohn evidences the use of a device with a flexible extension and a sharp end adapted for being grasped by a hollow needle, at a side of the sharp tip opposite of the extension or at a side of the extension to prevent cracking and chipping of bone.

Therefore, given the teaching of Sohn, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Pietrzak et al., as taught by Sohn to prevent cracking and shipping of bone.

Response to Amendment

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Applicant's arguments with respect to claims 63,65 have been considered but are moot in view of the new ground(s) of rejection.

However, applicant's arguments that no election of species was required in the PCT written opinion is not persuasive, since all of the claims could be searched in a PCT, as long as applicant pays the required fees. Furthermore, applicant stated that on the reliance on the Office Action, applicant originally elected Group IV, which the Office Action said corresponded to claims 62-65. In the last Office Action, Examiner explained to the applicant that claim 62 was inadvertently written in both Group III and Group IV, but claim 62, for obvious reasons, belongs to Group III. Applicant stated that at least one independent generic claim does exist in this case, however, to the examiner's knowledge there is no generic claim in this case.

Conclusion

A shortened statutory period for reply to this action is set to expire THREE MONTHS from the mailing date of this action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (703) 308-2252. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pedro Philogene
February 3, 2004



PEDRO PHILOGENE
PRIMARY EXAMINER